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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,312	01/11/2002	Kanji Yahiro	2001_1892A	4407

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EXAMINER

SMITH, CAROLYN L

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/042,312

Applicant(s)

YAHIRO, KANJI

Examiner

Carolyn L Smith

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 15.

Claim(s) rejected: 1-15.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: Previously submitted claim 1 was directed to an evaluation apparatus and method for acquiring numerical data showing a state of a generic biological sample, whereas newly proposed amended claims 1 and 6 involves a biological sample "including" a cell having a linear structure extending from a main body of a soma. This newly proposed limitation differs even from the previously submitted claims 5 and 10 which were directed to a biological sample that "is" a cell. Because the biological sample in the proposed amended claims 1 and 6 is different from what was previously claimed, these amendments raise new issues. This similar issue also occurs in proposed amended claims 11 and 15, respectively. The added limitation of "deleting the linear structure from the image of the biological sample" in proposed amended claims 1, 6, and 11 raises a new issue. The limitation involving the determination of "a number of main bodies, as a number of somas" as stated in proposed amended claims 1, 6, and 11 raises a new issue. The limitation wherein the length is that of the linear structure as stated in proposed amended claims 5, 10, and 15 raises a new issue.

Continuation of 5. does NOT place the application in condition for allowance because: the presence of new issues which would require further consideration and search. In addition, the proposed claims with amended limitations do not place the application in better form for appeal. Because the amendment will not be entered, all previous objection and rejections are maintained. If the proposed amendment had been entered, the claim objection; the 35 USC 112, first paragraph NEW MATTER rejections; the 35 USC 112, second paragraph rejections; and the 35 USC 102 rejection would have been overcome. A further search would be required to determine if the 35 USC 103 rejections would be maintained due to the presence of new issues.

Ardin H. Marschel 10/12/04
ARDIN H. MARSCHEL
PRIMARY EXAMINER